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Supreme Court of the United States

OCTOBER TERM—1941.

No. 1034.

RICHARD E. MARINE,

Petitioner,

VS.

CONWAY P. COE, Commissioner of Patents.

REPLY BRIEF FOR PETITIONER.

RICHARD E. MARINE,

Pro se.

CHARLES S. GRINDLE,

Of Counsel.



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Note: P. B. as herein used refers to "Petition and Brief" for Petitioner.

R. B. as herein used refers to "Brief for the Respondent in Opposition".

Appendixes D and E are reproduced herein because the former reproductions were imperfect.

The petitioner and the respondent do not seem to agree as to the questions presented on this petition. On pages 18 and 19 of the petition, these are stated to be seven in number, of which the first five are specific. On page 2 of the respondent's brief, however, these seven are wholly ignored, and two others are substituted that appear to be entirely beside the point.

The Petitioner's Question 1. The Issue Is Not *Res Judicata* As Against the Petitioner, But Claim 5 Is *Res Judicata* In Favor of the Petitioner.

On page 7 of the respondent's brief, it is stated that the issue is *res judicata*, reference being to Interference No. 61,642 alone. But the only basis for the

holding on this ground is the confused and untenable test of *res judicata* adopted in the District Court's opinion at the bottom of page 2 and the top of page 3 of the petition. This test is challenged by the first question presented, on page 18 of the petition for the reasons stated under 1, on pages 19 and 20.

The District Judge's reasoning, it is submitted, was wrong. The matter is not *res judicata* because the subject matter in said interference is not the same as that involved in the present proceeding. The count in said interference did not specify nor do Wright's specification or drawings disclose the three features of the claims here at issue, specified in the last four paragraphs, page 15, continuing down to "14" on page 16 of the petition. It was in effect so held in said interference (P. B. 14, first quotation) and this finding of fact is here *res judicata* in favor of petitioner. The respondent's brief affords no help whatever toward the solution of the problem presented by petitioner's question 1.

As explained on page 3 of the petition, moreover, the principle of *res judicata* would not be applicable in any event, because of newly discovered evidence, which had previously been fraudulently suppressed by Wright and which did not become available to the petitioner until long after the interference had terminated.

This new evidence was constituted of an admission by Wright himself as to the lack of utility of his Fig. 2 post, which figure is solely relied upon by respondent to anticipate claims 5 and 57 here at issue. This post Wright has now admitted to be weak and not strong (P. B. 12). Attention is invited to the paragraph numbered 7 on page 5 of the petition, and to the bottom of page 10 and pages 11 and 12. The fifth question, printed on page 19, bears

on this. It is submitted that this admission voids Wright's disclosure as an anticipation of claims 5 and 57 and is alone conclusive of the patentability of the claims at issue.

In reality, however, the issue as to claim 5 is *res judicata* in favor of the petitioner, as explained under item 6, pages 4 and 5 of the petition and also pages 16 and 17.

The record shows that petitioner has invented a strong post, as distinguished from the admittedly weak Wright post. The record shows also that the claim involved in Interference No. 61,642, *Marine v. Wright*, was originally allowed to the petitioner, before the interference was declared, as specifying a strong post, thus defining over the prior art. The record shows that, ignoring this meaning thus assigned to the claim, it was later, in the interference, under well established interference rules, construed as broadly as possible, including even the prior art weak posts and the Wright weak posts.

The Petitioner's Question 2. The Petitioner Is the Victim of Technical Rules.

The second question, presented on page 18 of the petition, therefore, is whether, after a claim had been construed to be patentable over the disclosures of prior patents (as explained in the paragraph numbered 10, on pages 7 and 8 of the petition), the meaning thus assigned to the claim may then be ignored for interference purposes. This is explained, with a quotation from the decision of the Court of Customs and Patent Appeals, on page 13 of the petition. It was only because of the ignoring of the meaning originally given to petitioner's original claim 14,

necessary to render it patentable over the prior patent to Carlson, that it became the count of the Wright Interference No. 61,642 (see also the bottom of p. 12 and p. 13).

With the new meaning thus assigned to the count, it became unpatentable over the prior art, but since, as held in the quotation just referred to, the question of patentability is not considered in interferences, priority was awarded to Wright. This practice gives no weight to the applicable decision of this Court in *Hill et al. v. Wooster*, 132 U. S. 693, as explained on pages 13, 20 and 21 of the petition and conflicts with the practice in the Sixth Circuit as stated in *Clements v. Kirby*, 274 Fed. 575, 581, 582.

The Petitioner's Question 3. This Court Has It In Its Power to Change These Unjust Technical Rules.

Once the interference was over, the petitioner presented a new claim (57 here at issue) that would define over the unpatentable count and over Wright's disclosure by embodying the distinctions found to exist between Wright's disclosure and petitioner's in Interference No. 61,642 (P. B. 14, first quotation); the omission of the word "substantial", which had been responsible for all the conclusion up to that time, and specifying that the post, alone, subtended the blind angle, thus giving over to it the full width of the blind angle to obtain maximum lateral strength, the door or window end frame member lying entirely within said angle, overcame the difficulty (P. B. 15, 16). This word "substantial", it had been held in the inter partes proceedings, rendered the count in interference broad enough not to be restricted to

maximum strength posts, but to also include weak posts (P. B. 14, first quotation). The new claim was carefully drafted to cover only petitioner's strong post—not disclosed by Wright. The new claim, however, was then held to be *res judicata* in view of the outcome of the interference. This raises the third question, presented on page 19 of the petition.

This is an important question because, through these technical rulings, the plaintiff has been deprived of a patent for maximum-strength-post invention that he alone made, and that Wright, in his accidental disclosure, did not make, as explained on pages 14 (last paragraph) to 16 of the petition. The effect of this action was to reject petitioner on his own invention, for had the interference never existed and had its unpatentable count never been the basis of an award of priority to Wright, the Wright patent when issued would never have been held an anticipation of claim 57, more than would Carlson (P. B. 9, first paragraph) over which even the imperfect interference count, as construed by the examiner before the interference, had been allowed (P. B. 20, 21, 22).

The Petitioner's Questions 4 and 5. This Court's Prior Decisions Have Not Been Followed.

The fourth and fifth questions, presented on page 19 of the petition, refer to matters of sufficiency of disclosure and utility fully discussed on pages 5, 9 to 12, 21 (last paragraph), and 26-29. These are most important questions because disregard of them results in the encouragement of fraud.

The Petitioner's Questions 6 and 7. Application of the Above Principles to Petitioner's Case.

These questions are considered generally on page 22 of the petition and are fully answered specifically in the consideration of the previous questions.

Respondent's Question 1. Does the Record Evidence Support the Conclusion of the District Court that Claims 5 and 57 are Disclosed In the Prior Art, i. e., Wright.

For support of his answer in the affirmative respondent, on page 6 of his brief, states that the patent application of Wright, who had been involved in several interferences with petitioner, "described the *front face* of his post as 'extending rearwardly at an angle in line with the normal line of vision of the automobile driver' * * * which, by its terms, negatives the suggestion that Wright's illustration of 'substantial alignment' in the accompanying drawing was *merely accidental*." (Italics ours.)

It described no such thing. The District Judge refused to accept this argument. No final decision on priority of any tribunal in Interference No. 61,642 accepted Wright's repeated arguments to the same effect. Wright never disclosed petitioner's invention and therefore never disclosed its principle as asserted by respondent on the same page of his brief. The only reason that Interference No. 61,642 was declared was because of a draftsman's error, as explained on pages 8 to 14 of the petition. Respondent's quotation from Wright's application is partial only. The complete quotation (R. 180, fol. 1004) is

given in the first column below. In the second column is quoted a parallel statement also occurring in Wright's original specification as filed (R. 181, last sentence, ending on 182):

<p>“The pillar 10 is formed with a corner portion 11 having sides 12 and 13 and an <i>elongated extension 14</i> extending rearwardly</p>	<p>“The front pillar may be described as <i>a flat pillar of narrow width</i> positioned</p>
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<p><i>at an angle in line with the normal line of vision of an automobile driver.”</i></p>	<p><i>at an angle in line with the center line of vision indicated at 24.”</i></p>
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(Italics ours.)

Both of these quotations, by reference to their antecedent statements describe Wright's Fig. 2 (P. B. Appendix B). The first quotation declares that it is Wright's *elongated extension 14*, or the flat pillar of narrow width of the second quotation, and not the *front face* of the extension 14, which is in alignment with a line of vision of the driver and the second quotation declares that in Fig. 2 it is the *center* line of vision 24, and not the *side* line of vision 23 necessary to sustain respondent's argument, which is in such alignment. Wright's whole disclosure and his original claims 1 to 4 (R. 143) are built about this *center* line of vision 24. Wright's arguments were, in effect, directly overruled by the holding of the Court of Customs and Patent Appeals (P. B. 14) that there was inconsistency between Wright's Fig. 1 and 2 “as indicated by the projected lines of vision”.

Wright, himself, has admitted wherein the inconsistency resides, for his admission quoted on page 12 of the petition definitely states that his diamond-

shaped area of Fig. 1 has been deformed on one side, in his Fig. 2, resulting in the weakening of his post in that figure, which was obviously never intended.

Respondent's Question 2. Can an Unsuccessful Party In an Interference Proceeding Subsequently Obtain Claims Substantially the Same as Those Involved In the Interference Proceeding.

The direct answer to this question is that petitioner's claims 5 and 57 are not substantially the same as the count in Interference 61,642 as therein construed. In the decisions of all of the tribunals on priority in Interference 61,642, consideration of the patentability of the count over Carlson, when given the "latitude" expressly imposed upon it by said tribunals, was expressly refused. The holding of the Court of Customs and Patent Appeals on this point is quoted on page 13 of the petition. It has heretofore been fairly established that petitioner's "alignment" and the "substantial alignment" of the interference count are different both in structure and in function and it was so definitely held by the examiner of interferences (P. B. 14), whose decision was adopted by the Court of Customs and Patent Appeals. Moreover, Wright's belated admission that substantial alignment weakened his post (P. B. 12) definitely establishes that his "substantial alignment" is in no sense the equivalent of petitioner's "alignment" which strengthens his post. As pointed out on page 11 of the petition, *alignment* carried to its *full extent* in Wright's Fig. 2 under his admitted theory of a diamond-shaped area, would utterly destroy his post extension.

In *McBride v. Jeeple, Jr.*, 109 F. (2d) 789, it was held by the same Court of Customs and Patent Appeals that "substantially" is not the same as "completely", and this principle is applicable here if it ever was anywhere.

Respondent's brief ignores the fact that interferences are between *things* not *words*—and that it is the substance and not the shadow with which we deal (*Blackford v. Wilder*, Rev. 28, App. D. C. 535, 544). As has been aptly said, "it is not parts of speech but parts of iron and steel with which we deal".

Respondent's brief, page 7, quotes petitioner as testifying that "in none of these cases can you fix an absolute position of the driver's eye". This again is a partial quotation. The essential part of petitioner's testimony here was as follows:

"Q. That is, the full length of the post lies within the angle of vision past the post? A. The full length of the post is in line with the line of vision past it; in other words, the cross-sectional area of the post extends to and is bounded on one side for substantially its full length by the driver's line of vision, there is no angle in there.

Q. And if there were any angle between the side of the post and the side of the blind angle, that claim would not respond to such a structure, would it? A. It would not unless the angle was intended not to be there, and was so close that it really was the same thing. There must be intent. If there is a substantial angle, if the angle is very substantial, and nothing to base it on, then it certainly would not be that claim; it does not get the benefit of increased area or increased strength.

Of course, I might say in none of these cases can you fix an absolute position of the driver's eye; a big man might have a different position from a small man, but it is approximately, it is very close to the center of the seat; neither does he move his head much when he is driving, and if the designer of the post intends to give him the best vision possible by utilizing as much as possible the blind angle for the post, he is doing a very important thing, and minor deviations, where intent is present, and where the teaching is present, still insure a strong post."

The sketch, Appendix C, page 32 of the petition, shows that to obtain alignment between the face of the post in Wright's correct Fig. 1 and the driver's eye the driver must move his head through the wide angle from the line 24 to the line B which is near the side of the car and even in his erroneous Fig. 2 it would be necessary in order to obtain such alignment for the driver to move his head through the very substantial angle between the line 24 and the line D. And to what purpose? Certainly the clearness of vision would not be enhanced thereby, whereas any possible adjustment required to obtain exact alignment in petitioner's post, as exemplified in Appendix D, page 15, of this brief, would be comparatively infinitesimal and would have the great advantage that it was incident to the use of a strong post without increased obstruction to vision.

The principles here involved are most readily appreciated from a consideration of Petitioner's Physical Exhibit 2 (R. 17) which shows what Wright's disclosure would have been if he had contemplated the benefits of true alignment disclosed by petitioner's application. Physical Exhibit No. 7 (R. 28) shows in its lower section the physical embodiment of

Wright's Fig. 1 and in its hinged upper section, when expanded to its furthestmost limit, also Wright's Fig. 1, but when contracted to its innermost limit it shows Wright's Fig. 2. The white lines portray the lines of vision of Fig. 1 and the red lines the lines of vision of Fig. 2. By manipulation of this model an understanding of the questions herein raised becomes much simplified. Both Exhibits 2 and 7 are full size.

In Petitioner's Exhibit 10 (R. 45) is shown in blue the cross-section of petitioner's post and in red the cross-sections of Wright's Fig. 1 post with the details of his Fig. 2 embodied therein and also in the same color is shown a cross-section of Carlson's post. There is also superimposed on the blue post of petitioner the Emond post. All of these posts were based on a two and a half inch transverse dimension in the original Exhibit 10 and the excess of blue area on each side of the superimposed posts visually indicates the excess strength of petitioner's post over all three of the superimposed posts combined. This exhibit also shows the striking similarity of the Carlson and the Wright posts which was in fact held by the primary examiner in finally rejecting many of the Wright claims before declaration of Interference No. 61,642 (R. 148). Following this rejection Wright cancelled said claims (R. 149).

The principles of *res judicata* stated on page 7 of respondent's brief are recognized by petitioner but he submits that they are not applicable to the instant case. The suggestion of examiner that petitioner's claim 5 would be held subject to rejection in the event of an adverse decision in Interference No. 61,642 was merely a warning and not a well considered action taken after the facts determined in the interference proceedings were known. A similar notice involving

petitioner's same claim 5 was given in Interference No. 61,644, some of the counts of which Wright attempted to make and which was later consolidated with Interference No. 61,643 in which Wright was a party and in which interference petitioner prevailed. These interferences involved the subject matter of claim 5 and Interference No. 61,642 did not. Therefore, if any weight is given to this notice we submit that it would be in favor of petitioner. Moreover, since petitioner was already asserting right to the claim, the duty devolved on Wright and not on petitioner to seek an interference thereon. However, there is a more fundamental reason why petitioner could not ask that this claim be placed in interference with Wright. The Patent Office practice requires that any party seeking to add a claim to an interference must apply that claim to the structure of his opponent and show that his opponent has the right to make it, as a condition precedent to even the consideration of his motion. Here petitioner has emphatically denied Wright's disclosure of claim 5 and to have attempted to make a showing of the character indicated, in order to get said claim in the interference, he would have had to admit that Wright could make the claim and would thereafter have been estopped from challenging such right had the count been admitted to interference. Certainly no party can be required under penalty to make an admission which in good conscience he must deny.

It is submitted that claim 5 could not have been presented by applicant for interference with Wright under the provisions of Rule 109.

Conclusion.

We therefore submit that the decision of the court below does not rest upon the findings of fact which are supported by the evidence and that petitioner's questions 1 to 5 inclusive are of fundamental importance to patent rights in general and to petitioner's rights in particular. It is therefore respectfully submitted that the petition for writ of certiorari should be granted.

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